

### **REMARKS/ARGUMENTS**

Favorable reconsideration of this application, as currently amended and in light of the following discussion, is respectfully requested.

Claims 5 and 9-11 are presently pending in this application, Claims 1, 2, 8 and 12-15 having been canceled by the present amendment.

In the outstanding Office Action, Claim 8 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement; Claims 1, 2, 5 and 8-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wainberg et al. (U.S. Patent 5,075,025) in view of Taylor et al. (U.S. Patent 6,107,261), Wainberg et al. and Taylor et al. in view of Choy (U.S. Patent 5,705,467) or Choy in view of Wainberg et al.

Regarding the rejections of Claims 1, 2, 8 and 12-15, Applicant respectfully requests that Claims 1, 2, 8 and 12-15 be canceled without prejudice.

Before addressing the outstanding rejection based on the cited references, a brief review of Claim 5 is believed to be helpful. Claim 5 is directed to a method for suppressing smell change or odor generation with passage of time in a cosmetic and recites “preparing a composition including at least one surfactant having an oxyethylene group; and adding a suppressant comprising tert-butanol to said composition, the suppressant suppressing smell change or odor generation caused by the at least one surfactant, wherein the at least one surfactant comprises at least one material selected from the group consisting of materials represented by the following general formula (1):  $[R^1(OCH_2CH_2)_n-OSO_3]^- M^+$  wherein  $R^1$  represents a linear or branched alkyl group having 7 to 21 carbon atoms or a linear or branched alkenyl group having 7 to 21 carbon atoms, n represents an integer of 1 to 30, and M represents Na, K,  $NH_4$ , or triethanolamine; materials represented by the following general formula (2):  $R^2CO-NH(CH_2CH_2O)_mH$  wherein  $R^2$  represents a linear or branched alkyl group having 7 to 21 carbon atoms or a linear or branched alkenyl group having 7 to 21 carbon

atoms, and m represents an integer of 1 to 10; materials represented by the following general formula (3):  $R^3CO-N(CH_2CH_2OH)_2$  wherein  $R^3$  represents a linear or branched alkyl group having 7 to 21 carbon atoms or a linear or branched alkenyl group having 7 to 21 carbon atoms, and tert-butanol is added in an amount of 0.01 to 1,000 ppm based on a total weight of the composition.”

By adding a suppressant comprising tert-butanol in such an amount, the cosmetic composition produces less smell change over time, and undesired odor or smell change caused by the surfactants over time is effectively suppressed, as shown in the previously filed attached Declaration. The declaration also shows that a composition containing an excessive amount of tert-butanol, *i.e.*, more than 1,000 ppm, produces unfavorable odor.

The outstanding Office Action states that “[i]t would have been obvious ... to incorporate the surfactants of Taylor in the antibacterial composition of Wainberg”<sup>1</sup> and that “while Wainberg and Taylor do not teach the suppression of odor caused by surfactants, according to Wainberg t-butanol is an odor masking agent and the resulting combination from the teachings of the Wainberg and Taylor not only reduced the odor caused by chlorite or Wainberg, but also possesses the ability to reduce the odor caused by surfactants.”<sup>2</sup> The Office Action further states that “[i]t would have been obvious ... to choose t-butanol as a tertiary alcohol in the cleaning composition of Choy, in combination with surfactants, solvents, electrolyte etc. ....”<sup>3</sup>

Nevertheless, none of Wainberg et al., Taylor et al. and Choy teaches or suggests suppressing odor caused by surfactants by adding certain effective amounts of tert-butanol as recited in Claim 5. Wainberg et al. simply discloses that the combination of t-butanol and hypochlorite in a disinfectant composition reduces the offensive odor resulting from the

---

<sup>1</sup> Office Action, page 4.

<sup>2</sup> *Id.*, page 5.

<sup>3</sup> *Id.*

hypochlorite, and merely states that the disinfectant composition may further contain fragrance and surfactant which is different from what is recited in Claim 5. Furthermore, as discussed in the previous response, Taylor et al. states that “[t]he solvent and/or hydrotrope assists in solubilizing the antibacterial agent, and reduces the affinity of the antibacterial agent to enter surfactant micelles”<sup>4</sup> and for this purpose, the composition of Taylor et al. contains hydric solvent or hydrotrope, and the amount of hydric solvent is 0% to about 25% of hydric solvent, most preferably about 5 % to about 20%. Taylor et al. teaches neither the use of a suppressant comprised of tert-butanol in a much smaller amount, *i.e.*, 0.01 to 1,000 ppm, to suppress the smell change or odor generation, nor the smell change or odor generation caused by surfactants. Choy merely describes that a solvent for its aqueous cleaning composition is selected from the class of terpene derivatives including a functional group and tertiary alcohols and lists a rather broad range of useful tertiary alcohols, *i.e.*, “R<sub>1</sub>, R<sub>2</sub> and R<sub>3</sub> contain from 1 to about 20 carbon atoms and are selected from a subgroup consisting of alkyl, cycloalkyl, carboxyl, carboxylate salt, ester, carbonyl, ether, nitrile, aryl aralkyl, and aldehyde moieties, and combinations thereof.”<sup>5</sup>

Based on the aforementioned reasons, Applicant respectfully submits that the resulting combinations proposed in the Office Action is a product of hindsight guided by Applicant’s disclosure, and it is believed to lack a proper motivation. Accordingly, it is believed that Wainberg et al., Taylor et al. and Choy fail to teach or suggest “adding a suppressant comprising tert-butanol to said composition, the suppressant suppressing smell change or odor generation caused by the at least one surfactant ..., wherein ... tert-butanol is added in an amount of 0.01 to 1,000 ppm based on a total weight of the composition”<sup>6</sup> as

---

<sup>4</sup> Taylor et al., column 11, lines 32-34.

<sup>5</sup> Choy, column 8, lines 25-37.

<sup>6</sup> Applicant wishes to point out that 0.01 to 1,000 ppm in the claim is converted to 0.000001 to 0.1% by weight, rather than 0.0001 to 0.1% by weight stated in the Office Action.

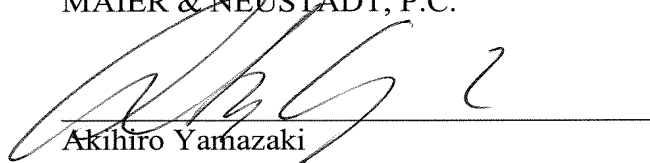
recited in Claim 5. Applicant therefore respectfully requests that the outstanding obviousness rejection of Claim 5 be withdrawn.

For the foregoing reasons, Claim 5 is believed to be allowable. Furthermore, since Claims 9-11 depend from Claim 5, substantially the same arguments set forth above also apply to these dependent claims. Hence, Claims 9-11 are believed to be allowable as well.

In view of the discussions presented above, Applicant respectfully submits that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

  
\_\_\_\_\_  
Akihiro Yamazaki  
Attorney of Record  
Registration No. 46,155

Customer Number  
**22850**

Tel: (703) 413-3000  
Fax: (703) 413 -2220  
(OSMMN 06/04)

AY/mda  
I:\ATTY\AKY\YO\24s\240114\240114US\_AME\_2.DOC